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10/541,997	02/07/2006	Kenji Muraki	MTS-3564US	6609
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary**

Application No.

10/541,997

Applicant(s)

MURAKI ET AL.

Examiner

CHRISTOPHER B. ARCHER

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 07/31/2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) 8-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07/13/2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 07/13/2005;08/31/2005.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The instant application having Application No. 10/541,997 filed on 02/07/2006 is presented for examination by the examiner.

### **Examiner Notes**

2. Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

### **IDS**

3. The examiner did not consider the IDS references because no English translation was provided. The examiner was not able to discern if the IDS references were related to the application.

### ***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 2, 4, 6, 7, and 11-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Rhoads et al. (US Patent No. 6,442,285), hereafter referred to as Rhoads.

**Regarding claim 1:**

Rhoads discloses "A recording apparatus which executes copy control utilizing copy control information which is formed by plural bits of digital data and indicative of plural types of copy control, comprising:

an electronic watermark detection means which detects predetermined certain bits of digital data in said copy control information out of a content over which an electronic watermark expressing said copy control information is superimposed; and

a recording means which records said content in accordance with a detection result obtained by said electronic watermark detection means."

**[(Rhoads column 13, lines 27-38) shows a copy control module with a watermark detection module and a recording module. The recording module will only copy content based upon a correct response from the watermark detection module.]**

**Regarding claim 2:**

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Rhoads discloses "The recording apparatus of claim 1 which is an SD apparatus complying with the SDMI control method,

wherein said copy control information is available in three types of "copy\_freely", "copy\_one\_generation" and "no\_more\_copy", and

said predetermined certain bits of digital data expressing "no\_more\_copy"."

**[(Rhoads column 4, lines 46-49) shows that SDMI is a common form of watermarking digital content. (Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes three states, "do not copy," "copy once only," and "unrestricted copying permitted."]**

**Regarding claim 4:**

Rhoads discloses "The recording apparatus of claim 2, wherein when the detection result obtained by said electronic watermark detection means indicates detection of said "no\_more\_copy", said recording means does not record said content, and when the detection result obtained by said electronic watermark detection means indicates that said "no\_more\_copy" is not detected, said recording means records said content."

**[(Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes three states, "do not copy," "copy**

**once only,” and “unrestricted copying permitted.” The names of these states are explicit as to their intended copy permission functionality.]**

**Regarding claim 6:**

Rhoads discloses “The recording apparatus of claim 2, wherein said recording means encrypts and records said content.”

**[(Rhoads column 13, lines 28-34 and 53-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals. This information is encoded and contains a watermark before it is copied, and to preserve the watermark's restrictions, the content must therefore be encrypted in the copy.]**

**Regarding claim 7:**

Rhoads discloses “The recording apparatus of claim 1, wherein said content is an audio content.”

**[(Rhoads column 13, lines 53-58) shows that the specific device being used is a music appliance.]**

**Regarding claim 11:**

Rhoads discloses "A playback apparatus which executes playback control utilizing copy control information which is indicative of plural types of copy control, comprising:

an electronic watermark detection means which do not detect said copy control information out of an SDMI-protected content recorded by an SD apparatus complying with an SDMI control method when said content is to be played back, but when an SDMI-unprotected content, which is a content other than said SDMI-protected content, is to be played back, detects a predetermined copy control information portion of said copy control information out of said content over which an electronic watermark expressing said copy control information is superimposed; and a

playback means which plays back said content when playback of said SDMI-protected content is desired, and play back said content in accordance with a detection result obtained by said electronic watermark detection means when playback of said SDMI-unprotected content is desired."

**[(Rhoads column 4, lines 46-49) shows that SDMI is a common form of watermarking digital content. (Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes copy and playback states, "do not copy," "copy once only," "unrestricted copying permitted," "play once," "play N times", and "unrestricted playing permitted." The names of these states are explicit as to their intended copy and playback permission functionality. (Rhoads, column 13, lines 27-**

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**34, 46-64) shows a system capable of reading a watermark and determining the copy and playback rights available to the user. (Rhoads column 13, lines 27-34 and 53-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals.]**

**Regarding claim 12:**

Rhoads discloses "The playback apparatus of claim 11 wherein said copy control information is available in three types of "copy\_freely", "copy\_one\_generation" and "no\_more\_copy", and

said predetermined copy control information portion is "no\_more\_copy".

**[(Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes three states, "do not copy," "copy once only," and "unrestricted copying permitted."]**

**Regarding claim 13:**

Rhoads discloses "The playback apparatus of claim 12 wherein when playback of said SDMI-unprotected content is desired, said playback means does not play back said content if the detection result obtained by said electronic watermark detection means indicates detection of said "no\_more\_copy", but said playback means plays back said content if the detection result obtained by said



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electronic watermark detection means indicates that said "no\_more\_copy" is not detected."

**[(Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes copy and playback states, "do not copy," "copy once only," "unrestricted copying permitted," "play once," "play N times", and "unrestricted playing permitted." The names of these states are explicit as to their intended copy and playback permission functionality.]**

**Regarding claim 14**

Rhoads discloses "The playback apparatus of claim 11 wherein said content is an audio content."

**[(Rhoads column 13, lines 53-58) shows that the specific device being used is a music appliance.]**

**Regarding claim 15:**

Rhoads discloses "A multi-function apparatus which executes copy control utilizing copy control information which is indicative of plural types of copy control, comprising:

electronic watermark detection means which detects copy control information out of a content over which an electronic watermark expressing said copy control information is superimposed;

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recording means which records said content in accordance with a detection result obtained by said electronic watermark detection means;

playback means which plays back said content in accordance with a detection result obtained by said electronic watermark detection means,

wherein for recording of said content, said electronic watermark detection means detects a predetermined copy control information portion of said copy control information out of a content over which an electronic watermark expressing said copy control information is superimposed, and

for playback of said content, said electronic watermark detection means detects all of said copy control information out of a content over which an electronic watermark expressing said copy control information is superimposed.”

**[Rhoads column 13, lines 27-34 and 53-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals.]**

**Regarding claim 16:**

Rhoads discloses, “A recording means which executes copy control utilizing copy control information which is formed by plural bits of digital data and indicative of plural types of copy control, comprising:

an electronic watermark detection step which detects predetermined certain bits of digital data in said copy control information out of a content over

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which an electronic watermark expressing said copy control information is superimposed; and

a recording step which records said content in accordance with a detection result obtained by said electronic watermark detection means.”

**[(Rhoads column 27-38, lines ) shows a copy control module which records content based on the copy control information provided in the content's watermark.]**

**Regarding claim 17:**

“A playback method of executing playback control utilizing copy control information which is indicative of plural types of copy control, comprising:

an electronic watermark detecting step at which when an SDMI-protected content recorded by an SD apparatus complying with the SDMI control method is to be played back, detection of said copy control information out of said content is not performed, and when an SDMI-unprotected content, which is a content other than said SDMI-protected content, is to be played back, a predetermined copy control information portion of said copy control information is detected out of said content over which an electronic watermark expressing said copy control information is superimposed; and

a playing back step at which said content is played back when playback of said SDMI-protected content is desired, and when playback of said SDMI-

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unprotected content is desired, said content is played back in accordance with a detection result obtained by said electronic watermark detection means.”

**[(Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes copy and playback states, “do not copy,” “copy once only,” “unrestricted copying permitted,” “play once,” “play N times”, and “unrestricted playing permitted.” The names of these states are explicit as to their intended copy and playback permission functionality. (Rhoads column 13, lines 28-34 and 53-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals.]**

**Regarding claim 18:**

Rhoads discloses “A recording/playback method for use in a multi-function apparatus which executes copy control utilizing copy control information which is indicative of plural types of copy control, comprising:

an electronic watermark detecting step detecting copy control information out of a content over which an electronic watermark expressing said copy control information is superimposed;

a recording step recording said content in accordance with a detection result obtained by said electronic watermark detection means; and

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a playing back step playing back said content in accordance with a detection result obtained by said electronic watermark detection means,

wherein when recording of said content is desired, at said electronic watermark detecting step, a predetermined copy control information portion of said copy control information is detected out of a content over which an electronic watermark expressing said copy control information is superimposed, and

when playing back of said content is desired, at said electronic watermark detection step, all of said copy control information is detected out of a content over which an electronic watermark expressing said copy control information is superimposed.”

**[(Rhoads column 13, lines 27-34 and 46-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals.]**

**Regarding claim 19:**

Rhoads discloses “A recording medium which can be processed on a computer and which holds a program of the recording apparatus of claim 1, said recording medium makes a computer function as:

a part of an electronic watermark detection means which detects predetermined certain bits of digital data in said copy control information out of a

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content over which an electronic watermark expressing said copy control information is superimposed; and

a part of a recording means which records said content in accordance with a detection result obtained by said electronic watermark detection means.”

**[(Rhoads column 8, lines 4-5) shows that modern media players are types of computers. (Rhoads column 13, lines 28-34 and 53-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals.]**

**Regarding claim 20:**

Rhoads discloses “A recording medium which can be processed on a computer and which holds a program of the playback apparatus of claim 11, said recording medium makes a computer function as:

an electronic watermark detection means which does not detect said copy control information out of an SDMI-protected content recorded by an SD apparatus complying with the SDMI control method when such a content is to be played back, but when an SDMI-unprotected content, which is a content other than said SDMI-protected content, is to be played back, detects a predetermined copy control information portion of said copy control information out of said content over which an electronic watermark expressing said copy control information is superimposed; and

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a part of a playback means which plays back said content when playback of said SDMI-protected content is desired, and plays back said content in accordance with a detection result obtained by said electronic watermark detection means when playback of said SDMI-unprotected content is desired.”

**[(Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes copy and playback states, “do not copy,” “copy once only,” “unrestricted copying permitted,” “play once,” “play N times”, and “unrestricted playing permitted.” The names of these states are explicit as to their intended copy and playback permission functionality. (Rhoads column 8, lines 4-5) shows that modern media players are types of computers. (Rhoads column 13, lines 28-34 and 53-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals.]**

**Regarding claim 21:**

Rhoads discloses “A recording medium which can be processed on a computer and which holds a program of the multi-function apparatus of claim 15, said recording medium makes a computer function as:

an electronic watermark detection means which detects copy control information out of a content over which an electronic watermark expressing said copy control information is superimposed;

a part of a recording means which records said content in accordance with a detection result obtained by said electronic watermark detection means; and

a part of a playback means which plays back said content in accordance with a detection result obtained by said electronic watermark detection means."

**[(Rhoads column 8, lines 4-5) shows that modern media players are types of computers. (Rhoads, column 13, lines 27-34, 46-64) shows a system that can detect copy control information inside of a watermark and a recording system that will react accordingly to each of the copy control signals.]**

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 3 and 5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rhoads, as applied to claim 1 above, in view of Maes et al. (US Patent No. 7,310,819), hereafter referred to as Maes.

**Regarding claim 3:**

Rhoads discloses "The recording apparatus of claim 1" and

"wherein said copy control information is available in three types of "copy\_freely", "copy\_one\_generation" and "no\_more\_copy", and



said predetermined certain bits of digital data expressing "no\_more\_copy".

**[(Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes three states, "do not copy," "copy once only," and "unrestricted copying permitted."]**

But Rhoads fails to explicitly disclose "which is a recording apparatus complying with the CPPM control method or the CPRM control method."

However, Maes discloses "which is a recording apparatus complying with the CPPM control method or the CPRM control method."

**[(Maes column 1 line, lines 41-63) shows that using Copy Protection for Recorded Media is common in the art.]**

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have applied the teaching of Maes into Rhoads as both are analogous art from the same field of endeavor of copy protection of digital media.

The ordinary skilled person would have been motivated to apply the teaching of Maes into Rhoads, as Maes provides additional information on copy protection of media.

**Regarding claim 5:**

Rhoads discloses "The recording apparatus of claim 3, wherein when the detection result obtained by said electronic watermark detection means indicates

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detection of said "no\_more\_copy", said recording means does not record said content, and when the detection result obtained by said electronic watermark detection means indicates that said "no\_more\_copy" is not detected, said recording means records said content."

**[(Rhoads column 13, lines 27-34 and 46-48) shows a use restriction embedded in a watermark that includes three states, "do not copy," "copy once only," and "unrestricted copying permitted." The names of these states are explicit as to their intended copy permission functionality.]**

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CHRISTOPHER B. ARCHER whose telephone number is (571)270-7308. The examiner can normally be reached on M-F 7:30-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Pham can be reached on (571)272-3689. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/CBA/

Examiner, Art Unit 4148

/THOMAS K PHAM/

Supervisory Patent Examiner, Art Unit 4148